

Remarks

Claims 1-9, 11-21, and 23-25 were pending in the application; of these, claims 12-14 have been withdrawn from consideration as drawn to non-elected species. Claims 1-9, 11, 15-21, and 23-25, as they read on the species of altered resistance to an herbicide, have been examined.

Claims 1, 5, 23-25 are amended to clarify language related to various types of mutant traits, and/or to re-emphasize the scope of the currently claimed embodiments. Support for language of the claims can be found throughout the specification and/or claims as originally found, including for instance as follows:

“recessive” mutant trait(s) -- page 6, lines 9-17; page 21, lines 21-24; and page 27, line 31 to page 28, line 20;

“dominant” mutant trait(s) -- page 3, lines 26-28; page 6, lines 9-17; page 28, lines 5-17 and line 23; original claims (e.g., 23-25);

“corn” -- page 11, line 14; and

“specific” mutant trait(s) -- page 34, line 24; original claims (e.g., 18, 19, 23, 26).

New claim 34 has been added; support for this claim can be found at least in claim 1 as it was pending at the time of the prior Office action. Claim 34 has been added to focus on the embodiment wherein mutant traits being recorded are morphological traits.

Applicants expressly reserve the right to pursue protection of any or all subject matter removed from the pending claims in one or more continuing applications. No new matter is introduced by the foregoing amendments. After entry of this amendment, **claims 1-9, 11-21, and 23-25, and 34 are pending in the application** (though claims 12-14 are currently withdrawn). Consideration and allowance of the pending claims is requested.

Applicants request rejoinder and consideration of the non-elected species (altered resistance to a pathogen, altered stress tolerance, and altered level of a biochemical component as exemplified in claims 12-14) once a claim directed to the elected species is found to be allowable.

Examiner Interview

Applicants thank the Examiner for the telephone interview on February 26, 2007, with their undersigned representative. During that interview, the pending rejections were discussed, as were suggestions for alternative claim language. Though agreement was not reached on all matters, Applicants believe current response is in accord with helpful suggestions made by the Examiner.

Claim Rejections under 35 USC §103

All of the pending claims are rejected as allegedly obvious in view of various combinations of references, which rejections are summarized as follow:

Claims	Primary References	Further in View of:
1, 15, and 16	BRIGGS <i>et al.</i> in view of JOHNSON <i>et al.</i>	
5, 6, 20, and 21	BRIGGS <i>et al.</i> in view of JOHNSON <i>et al.</i>	TISSIER <i>et al.</i> and SPEULMAN <i>et al.</i>
2, 3, 9, and 23-25	BRIGGS <i>et al.</i> , in view of JOHNSON <i>et al.</i> , TISSIER <i>et al.</i> , SPEULMAN <i>et al.</i>	NEFF <i>et al.</i>
4	BRIGGS <i>et al.</i> , in view of JOHNSON <i>et al.</i> , TISSIER <i>et al.</i> , SPEULMAN <i>et al.</i> , and NEFF <i>et al.</i>	DEY <i>et al.</i>
7, 11, 18, and 19	BRIGGS <i>et al.</i> , in view of JOHNSON <i>et al.</i> , TISSIER <i>et al.</i> , SPEULMAN <i>et al.</i> , and NEFF <i>et al.</i>	BHIDE <i>et al.</i>
8	BRIGGS <i>et al.</i> , in view of JOHNSON <i>et al.</i> , TISSIER <i>et al.</i> , SPEULMAN <i>et al.</i> , NEFF <i>et al.</i> , and BHIDE <i>et al.</i>	WILLIAMES
17	BRIGGS <i>et al.</i> , in view of JOHNSON <i>et al.</i> , TISSIER <i>et al.</i> , SPEULMAN <i>et al.</i> , NEFF <i>et al.</i> , and BHIDE <i>et al.</i>	SANDVIK <i>et al.</i>

Claim 1 is the only pending independent claim that was rejected; new claim 34 has largely parallel language. It is alleged in the current Office action (at page 3) that BRIGGS teaches all of the limitations of claim 1 except that it “does not specifically teach recording data in an electronic database”, which limitation is alleged to be taught by JOHNSON. This combination of two references (BRIGGS and JOHNSON) is relied upon for the rejection of each and every pending claim; no other rejections are pending. Applicants traverse this rejection, as

this combination of two references does not teach all elements of Applicants' claim 1 (or claim 34) as currently pending (and as claim 1 was pending in the prior response).

As discussed during the February 26 interview, it is Applicants' position that recessive mutations are identified in the claimed methods at least in step (f) of claim 1 (and claim 34). Applicants have amended claim 1 to specify that the method includes both "analyzing a transformed T1 plant grown in (b) for dominant mutant traits and recording in an electronic database at least one dominant mutant trait observed in the transformed T1 plant" and "analyzing a T2 plant grown in (e) for recessive mutant traits and recording in the database at least one recessive mutant trait observed in the analyzed T2 plant that was not present in its parent T1 plant". It is understood dominant traits also can be identified (and recorded) in the latter step, but at least one recessive trait is recorded.

Neither of the primary references relied upon in the current rejections, BRIGGS and JOHNSON, teach the identification, tracking, and analysis of both dominant and recessive mutations caused by random mutagenesis using an insertional mutagen. Further, none of the other references relied upon to reject dependent claims makes up for the deficiencies of the BRIGGS/JOHNSON combination of references. Thus, none of the other rejections can stand in view of the arguments made above. If an independent claim is non-obvious under 35 USC §103, then any claim depending therefrom is non-obvious (*In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, the rejections raised against dependent claims need not be addressed further herein. Applicants make no admissions or concessions regarding the assertions made in the Office action with respect to what the additional cited references disclose, or their relevance to the claims.

Applicants believe that none of the art of record, either alone or in any combination, fairly can be seen to teach the limitations of the currently pending claims.

Conclusions

It is respectfully submitted that the present claims are in a condition for allowance. If any issues remain, Examiner Moran is requested to contact the undersigned attorney prior to issuance

of the next Office action in order to arrange a telephone interview. It is believed that a brief discussion of the merits of the present application, and the language of the current claims, may expedite allowance of the claims.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 595-5300
Facsimile: (503) 595-5301

By /Tanya M. Harding/
Tanya M. Harding, Ph.D.
Registration No. 42,630